

REMARKS

Claims 1 and 12-19 are pending in the present application.

The Examiner has required election in the present application among:

Group I, claims 1-11 (in part), drawn to 1, 2, 4-oxadiazine compounds where R'HN-C=N-R together form a 1, 2, 4-oxadiazine ring (see compound 5 at page 17);

Group II, claims 1-11 (in part), drawn to 1, 3-imidazole compounds where R'HN-C=N-R together form a 1, 3-imidazole ring (see compound 6 at page 17);

Group III, claims 1-11 (in part), drawn to R = other heterocyclic ring; and

Group IV, claims 1-11 (in part), drawn to R = others.

For the purpose of examination of the present application, Applicants elect, with traverse, Group IV, Claims 1-11.

In the Office Action, the Examiner considers that the claimed compounds can be classified into four different groups of inventions, depending on the nature of the R and R' substituents.

Applicants submit that the grouping on the basis of the R and R' substituents, as proposed by the Examiner, derives from a dissection of the structure of the claimed compounds that is contrary to the restriction principles set out in the case law (*see In re Harnisch, Ex parte Holt and Randell etc...*), according to which the compounds of a Markush grouping are to be considered as a whole.

In particular, assert that at least groups III and IV should be rejoined. In fact, the separation of these groups by the Examiner is based on the reasoning that the special technical features of the above two groups of compounds are different: that of group III is R being

heterocyclic, while the one of the compounds of group IV is R being a group different from heterocyclic.

First, Applicants note that the definition given by the Examiner to group III as comprising the compounds of formula I wherein R=other heterocyclic group is not correct, since R=other heterocyclic group only when R is $(CH_2)_n-NRaRb$ and n is 0.

Furthermore, the compound 2a, cited by the Examiner does not fall into such definition. In fact, in compound 2a, R= $(CH_2)_n-NRaRb$ wherein Ra and Rb form an heterocyclic ring. (That is, "R" is not a heterocycle.)

As the Examiner will note, the special technical feature of the compounds that the Examiner has indicated as belonging to group III or IV, and wherein n is different from 0, is not the nature of the R group but the common core, Ar- $(CH_2)_n-NRaRb$ -amidinic group. As it has been demonstrated in the application, the presence of such common structural feature is associated with a common activity, which is the ability to inhibit IL8-induced chemotaxis.

The claims thus encompass compounds having a common structure (defined by Formula I) and a common activity of inhibition of IL8-induced chemotaxis of PMNs. Accordingly, division of claim 1 into several restriction groups is improper.

All of claims 12-19 encompass the elected subject matter and the generic original claim 1 is retained.

Responsive to the requirement for an election of specials, Applicants select the specific compound 2a ((R,S) 2-(4-isobutyl(phenyl)-N-[3"-N'-piperidino) propyl] propionamidine dihydrochloride) for initial search. Applicants submit that the Examiner should proceed to expand his search to encompass further compounds should compound 2a be found free of the prior art. All of the claims include this species.

Favorable action on claim 1 and 12-19 is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell, Ph.D., Registration No. 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

- Attached is a Petition for Extension of Time.
- Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: January 5, 2009

Respectfully submitted,

By Mark J. Nuell
Mark J. Nuell
Registration No.: 36,623
BIRCH, STEWART, KOLASCH & BIRCH, LLP
12770 High Bluff Drive, Suite 260
San Diego, California 92130
(858) 792-8855
Attorney for Applicant